

**Creation of Universal Data Base
- Problems and Advantages**

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1. Reliability

At the PCT Reform meeting held last year, the UK Delegation stated to the effect that Offices were, unfortunately, still reluctant to rely on work performed by other Offices, because of a lack of confidence.

Needless to say, confidence in reliability of work performed by any other Offices is essential to mutual recognition and acceptance of search results provided by any other Office.

In this regard, it is reported that in concurrent searches conducted by Trilateral Offices, the same conclusion regarding patentability with respect to both novelty and inventive step was reached in 90% of cases reviewed. However, it can be stated that a figure of 10% represents a fairly significant number of cases in which an accord in search results was not found. Moreover, within the 90% of cases for which search results were found to be in accord, when results between each of the 3 participating Offices are taken into account, in only 4% of cases were the same prior arts cited on the ground of novelty and inventive step, and between 2 Offices the number of cases in which the same prior arts were cited rises to 17%. It is noted that "patent families" were treated as the same document.

Establishing search guidelines and exercising a system of quality control are conceivable so as to improve conformity and reliability of search results. While acknowledging such a need, I believe, that in order to achieve such a goal, it is of fundamental importance to establish a universal prior art database for use by all ISAs.

2. Minimum Documentation

Under PCT Regulation, R.34.1, there is provided a requirement for "minimum documentation". However, what actually is considered to constitute "minimum documentation" differs among ISAs. This inconsistency can be seen as arising from the provision of R.34.1 (e).

Under the provision of R.34.1 (e), any ISA whose language is not Japanese, Russian or Spanish need not include in its documentation any patent documents written in Japanese, Russian or Spanish if a corresponding abstract in English is not generally available.

Further, according to the country publishing documents, mode of the document to be involved in minimum documentation is diverse.

Under these circumstances then, it becomes obvious that diverse search results among the various ISAs must be expected.

The requirement of "minimum documentation" is based on an assumption that English is a dominant language to be relied upon in assessing documentation. While, in principle, I believe that this assumption is, in itself, realistic, its practice does give rise to some problems. The documents published in English is almost perfectly involved. The same may be said with respect to some other languages, notably, French and German. However, the same cannot be said for other languages. With respect to some restricted languages such as Japanese and Russian, although the technological cultures of the countries are advanced only in the ISA whose official language is said restricted language, those documents are covered perfectly. In other ISAs, it is not of the minimum documentation. Thus, language referred to above, does not be involved in common.

Again, it is necessary to emphasize here that the production and dissemination of technology widely varies among different countries. Such variance is dependent on an equally wide variety of conditions which may include both cultural and economic factors. Inevitably, under the present system, there arises a problem that in a country in which a language other than an officially recognized language is used, and that country is relatively advanced in its technological development, documentation produced by the ISA will not be sufficient, and the result will be an insufficient and unsatisfactory search report.

3. Questions in the Present Search Based on the Present Minimum Documentation

3.1 English Documents

The ISAs in which English is the official language are able to carry out searches with almost no problem. However,

in those ISAs in which English is not the official language, the situation is different and it should be stated that such ISAs may not be able to carry out searches in a satisfactory manner.

Fundamentally, it is true that the Examiners belonging to any of the ISAs are expected to be able to understand English. However, it is natural that culture and environment, including a work environment, make it inevitable that an affinity will exist in examiners for their native language. Thus, a natural desire exists to conduct searches in a native language.

Reflecting this reality, in ISAs of non-English speaking countries, there is a tendency for documents published in English to become subordinate. Specifically, it is essentially the norm for documents consulted by an examiner under the requirement of "minimum documentation" to be in their native language, and for documents written in English that are consulted to be assessed on the basis of their abstracts or on abridgements of the documents. Fortunately, there exist many worldwide abstract supplier such as Derwent or CAS. In establishing a universal prior art database such a situation should be taken into account. Thus, requirements for abstracts written in English should be uniform among documents not only written in another language, but also in English.

3.2 Non-English Documents

(1) Abstracts

With regard to documents written in French and German, the same comments are applicable as those made with regard to documents written in English. In other words, the preparation of abstracts in English is indispensable.

With regard to documents that are published in another language, language discrimination which has arisen as a result of R34.1 (c)(vi), and which is preventing the object of "minimum documentation" being fulfilled globally, must be abolished. Thus, if such documents can be placed at the disposal of each ISA in convenient form, for example, in a form of an English abstract, such documents should be able to be readily utilized.

Based on the context, in order to establish of English abstract database with respect to the documents as above, systematic work should be proceeded, following Japanese

experience on the preparation of "Patent Abstracts of Japan".

It can be proceeded as a part of technical cooperation provided in Article 56.

(2) Original Documentation

In the foregoing, I have discussed the issue of providing a database of abstracts written in English. However, assuming that a proper database can be established, there remains the problem that an abstract can only function as a basis for a search of prior arts, and does not in any way in itself constitute an actual prior art. Thus, to check the veracity of a document uncovered on the basis of its English abstract in a search, it is necessary to study the entire document in its original language.

Linguistic diversity presents a problem here. Perhaps in the case of documents written, for example, in French or German, with the aid of dictionary resources it may be possible to proceed with such study to some degree. However, in a case that, for example, a language such as Japanese or Russian language is involved immense difficulties will be faced in any attempt to study original documentation which is uncovered by a search of English abstracts. In such cases, the only way to properly proceed will be by obtaining a translation of the document.

In relation to this problem, there has been expressed the idea of relying on machine translation. However, while such translation is able to provide a rudimentary map of a document, and might, for example, be applicable in translating simple abstracts, it is not a proper means for use in translating full documentation. If machine translation is relied upon for such documentation, without doubt, misinterpretation of documents as a result of improper translation will frequently occur. It is neither realistic nor possible to rely on machine translation, which at best, can provide a literal translation of nouns, noun phrases, and formulated syntax.

Such being the case, it is absolutely necessary to find a reliable and convenient method of proceeding confirmation to the original documentation uncovered by a search of English abstracts. I think that efforts towards finding a mutually acceptable solution commence without delay.

Since it is important to avoid any unfair and unexpected disadvantage being caused to an applicant by the above, in any case, invitation to applicants to submit their opinions would be inevitable, at least in the event that it has not been possible to confirm veracity of documentation for the reasons outlined above.

4. Suggestion for Construction of Universal Prior art Data Base

As I have asserted, if we are to attain mutual recognition of search results among national patent offices, the obvious and recommendable way forward will be the construction of a universal prior art database, which is able for the use and convenience of all ISAs.

Such a database should include all patent documents published by any of an international, regional, or national route with a basic condition that an abstract of any such document be generally available in English. For this purpose, it will be necessary for cooperation at an international level to be encouraged and proceeded with the work for preparation of the abstracts in English.

5. Revision of the Requirement of "Minimum Documentation"

1) The requirement of "minimum documentation", including the abolition of language restrictions arising from the provision of R.34.1 (C) (vi) should be revised. It is necessary to highlight the fact that for a variety of cultural, geographic and economic reasons technologies have been seen to develop in certain countries beyond the expectation of other countries. Examples in this regard might include China and Korea. Thus, in order to cover the documentation published in the countries, it will be necessary to periodically review the requirement of "minimum documentation". While it is certainly the case that a majority of globally influential inventions will be disseminated through the medium of the English language, it should be recognized the fact that many inventions are likely not to be disseminated in English, and may remain known and effective at a local and national level.

Further, it should be accepted that the somewhat arbitrary designation of a time period of "since 1920" which is unreasonable, and that it should therefore be abolished.

2) Inclusion of English abstracts of national patent documents published in any countries, in the provision of R.34.1 (c).

6. Additional Suggestions

1) Establishment of guidelines for preparing abstracts in English.

2) Establishment of guidelines for conducting effective searches.

3) Analysis of how veracity of original language documents uncovered by English abstract searches can be achieved.

4) Development of suitable retrieval system.

While putting forward the suggestions above, I must acknowledge the fact that their implementation will require a considerable investment of resources and finance.

7. Summary

Mutual recognition of search results is an important goal to be realized in the patent field.

To this end, establishment of a universal prior art database would be indispensable. To achieve this goal, the first step is revision of the requirement of "minimum documentation". In revising the requirement, as stated above, it is necessary to address to connected problems: standardization of means for uncovering relevant prior arts in a search; and, standardization of means for confirming veracity of an original document uncovered by such a search. These objects in a manner that is both effective and convenient.